

REMARKS

Applicant confirms the provisional election made without traverse by telephone on 5/21/2007. In the present response, claims 9-15 are canceled without dedication to the public of any of the subject matter claimed therein. Claims 1-8 remain pending and have been amended herein.

No new matter has been added by the claim amendments herein. For example, the amendments to claims 1 and 5 are supported by at least claims 3 and 6 of the application as originally filed. The amendments to claims 3 and 6 are supported by at least Figs. 1, 2, and 4 as originally filed. The amendments to claims 2 and 8 are supported by at least Figs. 1, 4, 5, 7, 10 and 11 as originally filed, each of those figures showing axial transition regions that are more tightly curved (i.e. smaller radius of curvature) than the base portion.

In the non-final Office Action mailed on 05/31/2007 claims 2 and 8 were rejected under 35 U.S.C. §112, second paragraph, as being allegedly indefinite. Those rejections are overcome herein by both amendment and traversal. Specifically, claims 2 and 8 have been amended to change the phrase “material thickness” to the word “thickness.” Support for this change in wording can be found at least at page 13, lines 21-23 of the specification as originally filed. The rejection of claims 2 and 8 is also traversed because it is well known that radius of curvature is always necessarily defined towards the concave side of a curve – not towards the convex side of a curve. Accordingly, the claim language “radius of curvature” is definite to one of ordinary skill in the art without any need to specify “the direction the radius of curvature is defined.”

Also in the non-final Office Action mailed on 05/31/2007, claims 1, 2, 4, 5, 7, and 8 were rejected under 35 U.S.C. §102(b), as being allegedly anticipated by US 2002/0039461 to Obara et al (hereinafter “Obara”). The rejection of these claims (as amended) is hereby traversed. In the first paragraph on page 11 of the non-final Office Action mailed 5/31/2007, the examiner correctly acknowledges that Obara fails to disclose or fairly suggest the claim limitation now added by amendment to independent claims 1 and 5. Specifically, Obara fails to disclose or fairly suggest that the ratio of the

axial transition length to the overall axial length is more than the ratio of the circumferential transition length to the overall circumferential width, but less than 250 times the ratio of the circumferential transition length to the overall circumferential width, as now required by all claims (as amended). For at least this reason, the rejections of claims 1, 2, 4, 5, 7, and 8 under 35 U.S.C. §102(b) have been overcome.

Moreover, claims 2 and 8 are not anticipated by Obara for the additional reason that Obara does not disclose or fairly suggest an axial transition region having a profile including at least one curve "spanning the axial transition length and having a finite radius of curvature that is less than the first radius," as required by claims 2 and 8 (as amended). On the contrary, Obara discloses only linear axial transitions, as acknowledged by the examiner on page 7 of the non-final Office Action mailed on 05/31/2007. For at least this additional reason, the rejections of claims 2 and 8 under 35 U.S.C. §102(b) have been overcome.

Furthermore, claims 3 and 6 are not anticipated by Obara for the additional reason that Obara does not disclose or fairly suggest an axial transition region that "includes a curved profile that spans the axial transition length, the curved profile being convex as viewed from within the tolerance ring and concave as viewed from outside the tolerance ring," as required by claims 3 and 6 (as amended). On the contrary, Obara discloses only linear axial transitions, as acknowledged by the examiner on page 7 of the non-final Office Action mailed on 05/31/2007. For at least this additional reason, the rejections of claims 3 and 6 under 35 U.S.C. §102(b) have been overcome.

Also in the non-final Office Action mailed on 05/31/2007, claims 3 and 6 were rejected under 35 U.S.C. §103(a), as being allegedly obvious over Obara in view of US 6,333,839 to Misso et al (hereinafter "Misso"). Despite amendments herein that remove the relevant claim limitations from claims 3 and 6, the obviousness rejections over Misso are not moot because the same claim limitations have been added to independent claims 1 and 5. Applicant hereby traverses the rejections under 35 U.S.C. §103(a).

Claims 1 and 5 (as amended) expressly require that "the ratio of said axial transition length to said overall axial length is more than the ratio of said circumferential transition length to said overall circumferential width." Neither Obara nor Misso disclose

or fairly suggest this claim limitation, alone or in combination. The examiner acknowledges that Obara fails to disclose or fairly suggest this claim limitation in the first paragraph on page 11 of the non-final Office Action mailed on 05/31/2007, but alleges in the subsequent paragraph that Misso teaches the claim limitation. That allegation is incorrect.

Figs. 7-9 of Misso depict a ratio of axial transition length to overall axial length of $\frac{1}{2}$ (0.5). Figs. 7-9 of Misso also depict a ratio of circumferential transition length to overall circumferential width of $\frac{1}{2}$ (0.5). Therefore, the Misso tolerance ring has a ratio of axial transition length to overall axial length *that is equal to* the ratio of circumferential transition length to overall circumferential width. This is not a trivial distinction, because the claimed inequality of ratios provides a stiffness benefit as described on page 14, line 22 through page 15, line 3 of the presently pending application. Since Misso does not teach or suggest the claimed inequality, Misso cannot correct the deficiency in the Obara art. Accordingly, no proper prima facie case of obviousness of the amended claims has been established based on the combination of Obara and Misso, and the claim rejections under 35 U.S.C. §103(a) should be withdrawn.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the pending claims are now in condition for allowance and requests reconsideration of the rejections. The Commissioner is hereby authorized to charge payment of any required fees associated with this Communication or credit any overpayment to Deposit Account No. 50-4119.

Respectfully submitted,



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By: _____

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